

Office Action Summary	Application No. 10/521,192	Applicant(s) STAUB ET AL.	
	Examiner JAMILA WILLIAMS	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9-10-08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim1 is rejected under 35 U.S.C. 102(b) as being anticipated by 2,326,375 to Garrard. Garrard discloses a security document (passport) comprising a number of pages (6) joined together by a fixing or adhesive (stitching 8), incorporated into the document by means of the fixing or adhesive is a transfer film (10) provided with security elements and which has a base film (10) and a decorative layer (12) which is provided with the security elements (uv material), the base film being releasably secured to the decorative layer arrangement and having an adhesive layer on a side remote from the base film (pressure sensitive uv material in area 12 transfers an invisible signature on the facing cover sheet and then the base sheet is removed- page 2 last paragraph).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3725

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4,6-9,16-17,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,808,792 to Weber in view of 2,326,375 to Garrard.

Weber discloses an individualized security document (passport, substrate 8 and column 1 lines 31-33 and column 2 lines 20-21 discloses the substrate being a passport) having a transfer film (figure 2) which is provided with security elements and which has a base film (3) and a decorative layer arrangement (7) having the security elements (12), the decorative layer arrangement having an adhesive 15 on the side remote from the base film. Weber also discloses in column 7 lines 39-44 that the transfer film element (17) be of a size that is the same as the size of the substrate (page of the passport) and the base film being releasably secured to the decorative layer arrangement (figure 2-3 of Weber).

Weber does not however disclose the security document (passport) having a number of pages and a transfer film joined together by means of a fixing or adhesive.

Garrard teaches having a security document (passport) having a number of pages (6) and including transfer film 10 joined by a common fixing (stitches 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pages and binding or fixing of Garrard with the passport of Weber for the purpose of securing various amounts of information together in the passport.

Regarding claim 2, Weber modified by Garrard discloses the transfer film provided with security elements is transparent column 3 line 42 of Weber).

Art Unit: 3725

Regarding claim 3, Weber modified by Garrard discloses the transfer film comprises paper (column 7 lines 48 and 55 of Weber).

Regarding claim 4, Weber modified by Garrard discloses the decorative layer (7 of Weber) having security elements is temporarily connected by means of a release layer (9 of Weber) to a carrier film (5 of Weber) which is permanently connected to the base film (3 of Weber) by means of permanent adhesive (4 of Weber).

Regarding claim 6, Weber modified by Garrard discloses the decorative layer arrangement is applied in the form of a label to the base film or the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 7, Weber modified by Garrard discloses the decorative layer arrangement is laminated onto the base film or onto the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 8, Weber modified by Garrard discloses the decorative layer arrangement is transparent or partially transparent (column 3 line 42 of Weber).

Regarding claim 9, Weber modified by Garrard discloses the base film and/or carrier film provided with position markings (perforations 16 are being considered the position markings).

Regarding claim 16, Weber modified by Garrard discloses the transfer film provided with security elements is of surface dimensions adapted to a page of the security document (column 7 lines 39-44 of Weber).

Regarding claim 17, wherein the transfer film is provided with security elements of surface dimensions adapted to a double page of the security document. It would have been an obvious matter of design choice to size the transfer film as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Garrard and further in view of 5,103,583 to VanErmen.

Weber modified by Garrard discloses most elements of the claims but for the base film having a window or opening.

VanErmen teaches having a label system having a base film (backing 12) with a window. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the window of VanErmen with the base film of Weber modified by Garrard for the purpose of viewing indicia or allowing for the addition of indicia on the underlying surface. It is noted that Weber discloses the transfer film as being label-like in its arrangement (column 6 lines 28-31 and column 7 lines 36-44 of Weber), therefore the combination with VanErmen would have been obvious to one having ordinary skill in the art.

Regarding claim 21, see rejection of claim 1 above.

6. Claims 10-15,18-20,22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Garrard and further in view of 4,533,160 to Malone.

Art Unit: 3725

Weber discloses that the transfer film is sized to be the same as the substrate (page of a passport-column 7 lines 39-44, this transfer film therefore essentially forms a sheet) and Garrard teaches having a passport book with multiple sheets (including transfer film) and stitching to combine the sheets.

Weber modified by Garrard does not however disclose the base film is provided with a perforation.

Malone discloses a book having layered sheets that are separated via perforations (24). In that the base film is part of the sheet bound in the book as taught by Weber modified by Garrard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the perforations as taught by Malone with the sheet of Weber modified by Garrard for the purpose for allowing for removal from the book.

Regarding claims 11-14, Weber modified by Garrard and Malone discloses perforations in layered sheets. Regarding the specific arrangement of the perforations, in that it is known to have perforations to separate the wanted portions of a sheet (or layers thereof) it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the position of the perforation as a matter of design choice. Additionally, the positioning of the perforation would have been obvious because applying a particular known technique to improve similar devices in the same way is recognized as part of ordinary capabilities of one skilled in the art.

Regarding claim 15, in that the base film of Weber modified by Garrard and Malone comprises paper it is inherently capable of supporting security features. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to include security features on the base film as suited for the intended use.

Regarding claims 18-19,22-23, see rejection of claim 10 above, see also figure 1 of Malone which illustrates a portion of the sheet 20 that remains with the booklet when torn along perforation 24).

Regarding claims 20,24 see rejection of claim 12 above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The 112 rejections from the previous action has been overcome by amendment.

Garrard is being introduced in this action to address the concept of having a common binding (stitch) between the transfer film and sheets of the booklet or passport document.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3725

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725